



UNITED STATES PATENT and TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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Mailed: JUN 23 2003

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Paper Number 13

In re application of  
Susumu Takagi et al.  
Serial No. 09/731,935  
Filed: December 7, 2000  
For: METAL COATED FIBER MATERIALS

:  
: DECISION ON  
: PETITION  
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This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed April 22, 2003.

On August 28, 2002, a non-final office action was mailed to applicant rejecting claims 1-18 under 35 USC 103. Claim 19 was not addressed in the office action except on the Office Action Summary Sheet which included claim 19 under the Disposition of Claims section. A reply to the office action was filed by Applicant on December 2, 2002. In the reply, Applicant put claim 19 into independent form (newly presented claim 20) including all of the limitations present in any intervening claims. On February 25, 2003, a final office action was mailed containing a 35 USC 103 rejection based on the same prior art as that which was made in the first office action. In the final office action, the rejection of claim 20 was added to the original rejection of claims 1-18. Applicants filed a request for withdrawal of finality on April 8, 2003 based on a premature final rejection. The examiner denied the request in an advisory action mailed April 22, 2003.

On May 6, 2003 the instant petition under 37 CFR 1.181 was timely filed to formally request the withdrawal of finality of the April 22, 2003 office action.

Petitioner's position for the withdrawal of the finality is that the new grounds of rejection in the final office action were not necessitated by Applicant's amendments to the claims.

## DECISION

Section 706.07 of the MPEP states:

### 706.07(a) Final Rejection, When Proper on Second Action

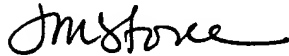
Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Petitioner argues that because claim 19 was not properly rejected in the first office action the subsequent rejection of claim 20 in the final office action was improperly made final. Claim 20 is originally filed claim 19, put in independent form. Applicants are correct that claim 19 was never

properly rejected in the non-final office action. While it appears that the examiner had meant to include claim 19 in the actual rejection, said claim was not addressed. The mere citation of the claim as being rejected on the Office Action Summary sheet is not sufficient to support a proper ground of rejection. Because the subject matter in newly presented claim 20 could have been rejected in the first office action but was not, the newly applied rejection to this claim was not necessitated by Applicant's amendment.

Accordingly, the petition for withdrawal of finality is **GRANTED**.

It is also pointed out that while the finality of the office action has been withdrawn, the rejection still stands. Applicant's time for response to the April 22, 2003 office action continues to run. Extensions of time may be obtained to file any amendments. Such amendments will be treated as amendments under 37 CFR 1.111.



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